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TECHNOLOGY CENTER R3700

P-3925-1

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*ECJ*  
*11/14/02*  
*#20*  
*Reg Record*  
*Peto*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: MARTIN CULLEN  
FOR: TILE WET SAW WITH OUTWARDLY DIVERGING CUTTING MODE  
SERIAL NO.: 09/864,350  
FILED: May 25, 2001  
EXAMINER: Maurina T. Rachuba, Primary Examiner, Art Unit 3723

PETITION PURSUANT TO 37 CFR 1.181(a)(3)

Hon. Commissioner of Patents  
and Trademarks  
Washington, DC 20231

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Sir:

1. Statement of the facts involved.

In the above-captioned application, applicant submitted the below claim for consideration on the merits:

2. A method of cutting in half in an optimum time a four-sided tile of ceramic construction material delimited by a front side, a rear side, a left side and a right side comprising the steps of:

- A. supporting from beneath said front and rear sides said tile in a horizontal orientation with a central clearance therebeneath at a tile-cutting work station;
- B. using a motor-operated circular cutting blade with a peripheral cutting edge at said tile-cutting work station mounted to partake from a starting clearance position a pivotal traverse to an operative position of movement into said central clearance beneath said tile with said cutting blade oriented perpendicularly of said left and right sides of said tile;

- C. positioning said tile with a center line and a central point therealong in the path of said pivotal traverse of said cutting blade;
- D. urging initially said cutting blade in said pivotal traverse into cutting contact at said central point of said tile to establish a start of a tile-severing cut along said center line; and
- E. continuing said pivotal traverse so as to cause said tile-severing cut starting in said tile simultaneously to enlarge in opposite directions along said center line until said left and right edges;

whereby said tile is cut in half in significantly less time than if said cut started in an edge thereof.

In an Office Action that preceded this Petition by less than two months, and more particularly dated 09/24/2002, the examiner stated:

“Since applicant has received an action on the merits [dated 07/11/2001 annexed as Exhibit A hereto] for the originally presented invention [claim 1 annexed as Exhibit B hereto] this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 2 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.”

**2. The point or points to be reviewed.**

The examiner has made reference to Section (b) of 37 CFR 1.142, but preceding

Section (b) is Section (a) set forth below:

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action. Underlining added.

The Code of Federal Regulations is explicit in the procedure to be followed in the circumstances at hand and this procedure provides applicant with a right of election to be made

in a reply to a “requirement for restriction” in an official action. This procedure was not followed, and since there was no official action with a “requirement for restriction” rendered by the examiner, applicant was precluded from exercising an option to either comply with “requirement for restriction” or to transverse the requirement.

The examiner’s substituted procedure, not sanctioned by the Code of Federal Regulations or by any other rule or cited authority, and merely asserted, by the examiner as being a constructive election resulting from presenting the prior claim 1 of Exhibit B is substantively prejudicial to applicant on two accounts.

First, claim 2 is not in the record and would not be presented for disposition in an appeal, which, incidentally, must be filed by the deadline of December 24, 2002.

Second, a “requirement for restriction” (also known as a “requirement for division”) is specified in 37 CFR 1.142(a) as required to be made “before final action” (underlining added). In the official action asserting the examiner’s “constructive election,” the official action was also a final action, and thus the former, “constructive election,” did not precede or occur before the latter, i.e., the final action.

**3. The action requested.**

1. The examiner should be ordered to enter claim 2 of Exhibit B in the record and to render a decision on the merits on the allowability of this claim.

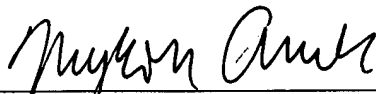
2. The prosecution of this application should be suspended pending the examiner’s decision on the merits of claim 2 and, if the decision is a rejection, the time for appeal should be extended thirty (30) days from the date thereof.

4. Payment of the requisite fee.

Please charge the fee of \$130 or other amount as required to Deposit Account  
01-1174.

Respectfully,

MYRON AMER, P.C.  
Attorney for Applicant

By:   
Myron Amer  
Reg. No. 18,650

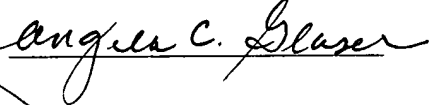
114 Old Country Road  
Suite 310  
Mineola, NY 11501  
(516) 742-5290

Dated: October 29, 2002

I hereby certify that this correspondence is being deposited  
with the United States Postal Service as First Class Mail in an  
envelope addressed to: Commissioner of Patents and  
Trademarks, Washington, D.C. 20231, on

Oct. 29, 2002

Dated: 10/29/02





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,350	05/25/2001	Martin Cullen	P-3925-1	2355

7590 07/11/2002  
MYRON AMER, P.C.  
114 Old Country Road  
Suite 310  
Mineola, NY 11501



EXAMINER

RACHUBA, MAURINA T

ART UNIT PAPER NUMBER

3723

DATE MAILED: 07/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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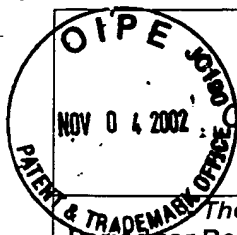
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# Office Action Summary

Application No.

09/864,350

Applicant(s)

CULLEN, MARTIN

Examiner

M Rachuba

Art Unit

3723

The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

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- 1) ☒ Responsive to communication(s) filed on 12 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final. TECHNOLOGY CENTER R3700
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

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## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 25, 2002 has been entered.

### *Claim Rejections - 35 USC § 102*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claim 1 is under 35 U.S.C. 102(b) as being anticipated by Sigetich et al, as set forth in the Office action mailed October 22, 2001.

### *Response to Arguments*

4. Applicant's arguments filed March 25, 2002 and May 16, 2002 have been fully considered but they are not persuasive. Applicant has argued that the tile saw disclosed by Sigetich et al does not function as applicant's saw. The recitation of the intended use of the claimed invention must result in a **structural** difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152

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USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). (emphasis added). Sigetich et al does not differ structurally from applicant's device. The examiner agrees that the method of operation of Sigetich et al may differ from applicant's method of operation, but such is not claimed as a distinct and independent invention. Applicant is directed to the actions mailed May 1, 2002 and May 29, 2002 for further discussion of this issue.

### ***Conclusion***

5. Any inquiry concerning the content of this communication or earlier communications from the examiner should be directed to M. Rachuba whose telephone number is (703) 308-1361. The examiner can normally be reached on Monday through Thursday, and alternate Fridays from 8:30 AM to 4:00 PM. Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail, can be reached on (703) 308-2687. The fax phone number for this Group is (703) 872-9302.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

M. RACHUBA  
PRIMARY PATENT EXAMINER  
ART UNIT 3723

mtr

July 10, 2002



1. A ceramic tile shaping saw comprising a circular blade having a peripheral cutting edge and of a diameter of at least 6 inches, motor means connected to power said circular blade in rotation, a saw housing having opposite ends, means at one end for mounting said housing for pivotally traversing movement, means at said opposite end for journalling said circular blade for rotation in extending depending relation therefrom, a ceramic tile at least of a 6 inch square configuration, a tile support in positioning relation beneath said tile and having an operative position located at an end of and in aligned relation to said path of said pivotal traversing movement of said housing, a descending movement of said housing along said path of said pivotal traversing movement effective to establish the contacting by said cutting blade centrally of a start of a first proposed cut therein during an initial pivotal traversing descent and during continued pivotal traversing descent a progressively enlargement thereof in one direction incident to contact with a length portion of said cutting blade in leading relation to said first cut and incident to contact with a length portion of said cutting blade in trailing relation to said first cut in an opposite direction until said tile is shaped into two parts, whereby said shaping is achieved in an optimum nominal time than would have entailed making said cut from one end thereof to the opposite end thereof.